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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,753	02/23/2005	Wojciech Sarna	542066-0321002	1118
909 7590 07/11/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
GORDON, BRIAN R				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
07/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/501,753

**Applicant(s)**

SARNA ET AL.

**Examiner**

Brian R. Gordon

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/08)
- Paper No(s)/Mail Date 4-25-05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1 it is unclear if applicant intends to claim the "tray and tips" as elements of the apparatus.

Claims 1-5 also employ the phrase "characterised in that". It appears as if applicant is using the phrase as a transitional phrase. This phrase is not generally considered a proper transitional phrase.

As to claim 2, the word "downwards" should be "downward". It is unclear what is protruding above the surface.

As to claim 3, the short tips are not positively claimed and it is unclear where the short tips are set.

As to claim 4, the long tips are not positively claimed.

3. Claim 1 recites the limitation "the feeder has on opposite walls" in line 4. There is insufficient antecedent basis for this limitation in the claim.

The claim is drafted in a manner which implies "opposite side walls are inherent features of the feeder". The claim does not previously establish the feeder includes walls.

It should be noted that reference numerals incorporated in the claim are considered structural limitations of the claim. However claim 1 implies walls 23 and 24 are opposite walls. According to figures, walls 23 and 24 are adjacent, perpendicular walls.

Claim 1 as drafted further implies an inner side, lower and upper edges are inherent features of the wedge-shaped projections.

As to claim 4, there is no antecedent basis for "upper portions" of long tips (35).

As to claim 5, there is no antecedent basis for "the lower portion".

#### ***Interview***

4. In an effort to expedite the prosecution of the instant application, the examiner phoned Tim Rooney on June 19, 2008 and submitted the proposed amendment below for approval. On June 27, 2008, the examiner contacted Mr. Rooney to inquire about the status of the proposed Examiner's Amendment. Mr. Rooney stated he had yet to receive any instructions from the client.

#### ***Proposed Examiners Amendment***

The application has been amended as follows:

Amend the claims as follows:

1. Pipette tip container comprising a base (1) ~~for setting~~ holding a tray (19) with tips (21) and a cover being a tray feeder (2), wherein the feeder (2) has ~~on a plurality of side walls (23, 24, 25, 26) including~~ opposite side walls (23, 24 25) comprising elastic holders (27, 28); ~~and~~ each of the elastic holders (27, 28) have ~~on an~~ an inner side including wedge-shaped

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projections (31, 32); ~~and~~

~~on upper edges~~ each of the wedge-shaped projections (31, 32) include a lower edge and an upper edge that supports the tray (19) with tips (21); ~~is supported, characterised in that~~

wherein the feeder (2) comprises elastic links (29, 30) between side walls (23, 24) and the elastic holders (27, 28) and

the base (1) comprises ~~in~~ opposite side walls (3, 5) including grooves (13, 14) for the elastic links (29, 30) of the feeder (2), wherein lower edges of the wedge-shaped projections (31, 32) abut against the opposite side walls (3, 5) of the base (1).

2. The container according to the claim 1, ~~characterised in that~~ wherein the feeder (2) has protruding downwards corners (15, 16, 17, 18), which cooperate with ~~protruding above top surface of the base (1)~~ corner guides (7, 8, 9, 10) of ~~this~~ the base (1), wherein said corner guides (7, 8, 9, 10) protrude above a top surface of the base.

3. The container according to the claim 1, ~~characterised in that~~ wherein the tray (19) includes short tips and said tray (19) has rings (34) around holes, wherein inside diameters of the rings (34) are equal to diameters of the holes and short tips (33) are set on upper edges of the rings (34) ~~short tips (33) are set.~~

4. The container according to the claim 1, ~~characterised in that~~ wherein the tray includes long tips (35) and an upper portion (22) of the feeder (2) has an inner

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stabilizing ring (36) that surrounds ~~surrounding an~~ upper portions of long tips (35), wherein an outside diameter dimension of ~~which~~ the upper portions of the long tips (35) is close to the spacing of holes in the tray (19).

5. The container according to the claim 4, ~~characterised in that~~ wherein the base (1) ~~comprises a~~ has in its lower portion including an additional bottom base (37) to house lower portions of long tips (35).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yiu, Felxi H.; Moritz; Jeffrey R. et al.; Arnold, Jr.; Robert W. et al.; Jessop; Paul M. et al.; Yiu; Felxi; Labriola; Anthony M et al.; Lahti; Arto; Steinbrenner; Bernd et al.; Taggart; Thomas; Astle; Thomas W.; Kelly; Christopher et al.; Lind; Peter M.; Lemieux; David J.; Stolp; Philip E.; Scaramella; Larry G. et al.; and Pardinas; Guillermo P. disclose pipette tip holders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/  
Primary Examiner  
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